

Appl. No. 09/911,916
Amdt. dated August 17, 2006
Reply to Office Action of May 17, 2006

REMARKS/ARGUMENTS

Applicants have received the Office Action dated May 17, 2006, in which the Examiner: 1) issued a Request for Information (RFI) under 37 C.F.R. § 1.105; 2) rejected claims 11 and 23 under 35 U.S.C. § 112, 2nd paragraph, as being indefinite; 3) rejected claims 1-3, 5-6, 8-12, 14-16, 18-19 and 21-31 under 35 U.S.C. § 103(a) as being unpatentable over Casati et al. "eFlow: a Platform for Developing and Managing Composite e-Services" (hereinafter "the Casati publication"); 4) rejected claims 7 and 20 under 35 U.S.C. § 103(a) as being unpatentable over the Casati publication in view of Web Services Flow Language (hereinafter "WSFL"); and 5) objected to claims 4 and 17 as being dependent upon a rejected base claim, but otherwise allowable. With this Response, Applicants respond to the RFI and amend claims 1, 2, 11, 14, 15 and 23. Applicants also cancel claims 4 and 17.

I. RESPONSE TO REQUEST FOR INFORMATION (RFI)

The Examiner previously issued an RFI to which Applicants responded. In that prior response, Applicants stated that:

to the best of Applicants' knowledge or belief, the "eFlow" platform was not released prior to 24 July 2000, or at any time after that date. Applicants also believe that no product, service, or product literature relating to the "eFlow" platform existed prior to 24 July 2000, or at any time after that date. Furthermore, insofar as Applicants are aware, the claimed subject matter has not been incorporated into any products or services.

Response dated February 21, 2006. In the present RFI, the Examiner states that "Applicant's previous response (received 21 February 2006) is noted, however, it is not understood with relation to the original requirement." The Examiner now requests more information.

In that the present RFI is based, at least in part, on the Examiner apparently not fully understanding Applicants' previous RFI response, Applicants wish to further elaborate as follows based on their knowledge. To the best of Applicants' knowledge, a product was not sold or offered for sale that includes the

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inventions as claimed in the present application. There were no sales or offers for sale before July 24, 2000 or afterwards. Further, to the best of Applicant's knowledge, a product was not sold or offered for sale that includes the subject matter of the Casati publication referenced by the Examiner in the present RFI. The eFlow project was a project worked on internally at Hewlett-Packard Company (HP), but was canceled without a product ever being sold or offered for sale.

The Examiner has enumerated three requests for factual statements. Each request asks Applicants to make a factual statement to explain something that the Examiner alleges is "in the "eFlow" platform publicly available April 2000 as evidenced by Casati et al., "eFlow: a Platform for Developing and Managing Composite e-Services," IEEE-Proceedings Academia/Industry Working Conference on 27-29 April 2000, pp. 341-348." The requests presuppose that the eFlow platform was indeed a publicly available product. Such was not the case as explained above. Thus, to the best of Applicants' knowledge, apart from the Casati publication itself, there is no other public awareness of the eFlow platform. That being the case, logically Applicants cannot provide the requested factual statements about a feature of the eFlow platform that was publicly available allegedly as evidenced by the Casati publication because, apart from the Casati publication, to the best of Applicants' knowledge the eFlow platform was never made publicly available.

Outside the RFI and in a different section of the Office Action, the Examiner requested a copy a document entitled "eFlow Model and Architecture," version 1.0 1999 by Hewlett-Packard which was cited in the Casati publication. To the best of Applicants' knowledge, this document was made available if someone requested it from HP, but to the best of Applicants' knowledge, no one ever requested the document. At any rate, Applicants can not readily locate a copy of the 7-year old document, a fact no doubt resulting from the cancellation of the aforementioned project.

Appl. No. 09/911,916
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To the extent the Examiner still needs more information besides what has already been provided, Applicants suggest that a telephone conference with the Examiner would facilitate promptly addressing the Examiner's concerns.

II. THE § 112, SECOND PARAGRAPH, REJECTIONS

The § 112 rejections have been addressed by amendment to claims 11 and 23.

III. THE ART REJECTIONS

The Examiner concluded that the limitations provided in dependent claims 4 and 17 comprise patentable subject matter. Merely to expedite prosecution of this case, and without acquiescing in the art rejections, Applicants opt to include the allowable subject matter of claims 4 and 17 in their respective independent claims 1 and 14. Applicants respectfully submit that the limitations from any intervening claims are not needed for patentability and thus have not also been included in independent claims 1 and 14. Based on the Examiner's own conclusions regarding claims 4 and 17, the Examiner should now readily agree that claims 1 and 14 and their dependent claims are in condition for allowance.

In addition to claims 1 and 14 being allowable by the Examiner's own reasoning, Applicants respectfully contend that claims 1 and 14 are allowable for additional reasons as well. First, claims 1 and 14 require "registering the composite process specification." The Examiner acknowledged that the Casati publication does not disclose this limitation but rejected the claim anyway. The Examiner's conclusion of obviousness is unsupported. That is, other than a bald assertion that the registration process as claimed would have been obvious to one of skill in the art, the Examiner has not provided justification as to why such a registration process would have been obvious. The Examiner is improperly using Applicants' contribution in hindsight. See e.g., *In re Dembiczak*, 175 F.3rd 994, 999 (Fed. Cir. 1999) (reversing the Examiner and precluding the PTO from falling victim to the "insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher"). Further, without documentary evidence of the "registration" limitation, the Examiner has made it difficult for Applicants to respond other than by saying that the art of record does not disclose

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the registration limitation and such limitation would not have been obvious to one of skill in the art. To the extent the Examiner continues to reject this claim, Applicants respectfully request the Examiner to find a prior art document that discloses this limitation.


For these reasons claim 1 and its dependent claims are allowable over the art of record. The same reasoning applies to claim 14 and its dependent claims.

Claim 23 requires a "means for registering..." The same argument above regarding the Examiner's conclusion that the Casati publication lacks a teaching of registration applies to claim 23 as well.

Claim 23 also requires a "means for structuring said first electronic service to be compatible with a given electronic services platform." The Examiner alleges that the Casati publication discloses this limitation on page 341, right column, first full paragraph. Applicants, one of which is the author of the Casati publication, have reviewed that paragraph and re-assert that the paragraph in question definitely does not disclose the claim limitation at issue. For these reasons, claim 23 and its dependent claims are allowable.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,


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Page 11 of 11

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